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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,563	10/23/2003	Frederic Legrand	05725.1255-00	6452
22852	7590	12/13/2007	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1615	
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			12/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/690,563

Applicant(s)

LEGRAND, FREDERIC

Examiner

JYOTHSNA A. VENKAT Ph. D

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of remarks and copy of certified foreign priority document filed on 10/29/07. Claims 1-59 are pending in the application and then status of the application is as follows:

In view of translated foreign priority document, the rejection of claims 1-59 under 103 over the combination of U. S. Patents 4,927,627 and 6,902,722 and the combination of U. S. Patents 4,927,627 and 6,955,803 and the combination of U. S. Patents 4,927,627 and 7,045,120 is hereby withdrawn. In view of applicant's remarks, the rejection of claims 1-59 under 35 U. S. C. 103 over the combination of U. S. Patent 4,927,627 and 6,287,543 and the rejection of claims 1-59 under 35 U. S. C. 103 over the combination of U. S. Patent 4,927,627 and 6,630,131 is hereby withdrawn.

The following rejections are maintained.

Claim Rejections - 35 USC § 103

Claims 1-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. patent '627 and PGPUB 20040074015 (PGPUB '015).

Patent '627 teaches hydrogen peroxide emulsions for bleaching hair. Patent teaches at col.2, lines 34-45 teaches hydrogen peroxide in the form of oil-in-water (o/w) emulsions and at col.3, line 18 teaches the concentration of the hydrogen peroxide, which is the oxidizing agent claimed. Patent at col.2, lines 51-65 teach anionic and nonionic surfactant and mixture of these surfactants. See also col.3, lines 8-17. Patent at col.2, lines 56-50 teaches the claimed fatty alcohols and in examples teaches cetyl alcohol claimed. Patent at col.3, under (f) teaches claimed stabilizers and under (g) teaches adding buffer agents so that pH is between 3-5. See examples

for additives. The difference between the patent '627 and the instant application is patent does not teach having amphilic polymer and the claimed hydrophobic unit.

However PGPUB '015 teaches oxidizing compositions using claimed cross-linked amphilic polymer and claimed hydrophobic unit. See the abstract, see paragraph 8 for the oxidizing agent, which includes hydrogen peroxide. See paragraph 9 for surfactant, see paragraphs 27-88 for detailed description of the claimed amphilic polymer and claimed hydrophobic unit. See paragraphs for detailed description of the oxidizing agent and see paragraph 97 for the claimed stabilizer, see paragraphs 218-220 for anionic and non-ionic surfactants.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compositions of '627 whcih is o/w emulsion having oxidizing agent, surfactant, stabilizer, fatty alcohol and combine it with amphilic polymer of formula I and hydrophobic unit expecting beneficial effect. One of ordinary skill in the hair care art would be motivated to add the amphiphilic polymer with the reasonable expectation of success that the amphiphilic polymer provides storage stability which is beneficial to the consumer. This is a prima facie case of obviousness.

Applicants state that "The present cases are indeed commonly assigned to L'Oreal and were at the time of invention".

Applicants do not state "Application X (instant) and PGPUB were at the time the invention of application X was made owned by company L'Oreal. See MPEP 706.02(1) (2) section II.

Double Patenting

Claims 1-59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-57 and 63-75 of copending Application No. 10/451,409 in view of U. S. Patent 4,927,627.

The instant application is claiming emulsion comprising oxidizing agent, surfactant, fatty alcohol and amphiphilic polymer and stabilizer. Copending application is also claiming oxidizing composition comprising oxidizing agent and amphiphilic polymer with hydrophobic unit and stabilizer. Co-pending application is claiming genus belonging to "amphiphilic polymer" and also the same amphiphilic polymer claimed in the instant application. Thus the genus claims in the co-pending application anticipates the species and when the claims are to species belonging to amphiphilic polymer in the co-pending application then both are same. Copending application is not to emulsions, but to compositions and copending application is not claiming fatty alcohol or surfactant. However patent teaches oil in water emulsions using hydrogen peroxide, fatty alcohol and surfactant. One of ordinary skill in the art would prepare compositions of 10/451,409 and add fatty alcohol and surfactant and use in the form of emulsions expecting that the emulsions are stable over long time in view of the amphiphilic polymer and the emulsions also exhibit improved depth of brightness.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

Applicant's arguments filed 10/29/07 have been fully considered but they are not persuasive.

Applicant traverse the provisional rejection and point out that the provisional rejection, at least because no actual double patenting circumstance can arise until a patent issues from the cited application and since the above copending application is still under consideration, there is the possibility that the claims therein may change and applicant further requests that any resolution in the form of a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c), if necessary, be deferred until such patent issues

In response, the claims in the co-pending application have not changed and the claims of the instant application are not allowable and therefore the provisional obviousness-type double patenting rejection is maintained.

Claims 1-59 are directed to an invention not patentably distinct from claims 1-57 and 63-75 of commonly assigned 10/451,409 in view patent '627. Specifically, for the reasons stated in the obviousness-type double patenting rejection.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/451,409, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

This rejection is also maintained since the statement under 103 (c) is not persuasive.

Claim Rejections - 35 USC § 103

Claims 1-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 4,927, 627 ('627) and 6,645,476 ('476) and 6,180,118 ('118).

Patent '627 teaches hydrogen peroxide emulsions for bleaching hair. Patent teaches at col.2, lines 34-45 teaches hydrogen peroxide in the form of oil-in-water (o/w) emulsions and at col.3, line 18 teaches the concentration of the hydrogen peroxide, which is the oxidizing agent claimed. Patent at col.2, lines 51-65 teach anionic and nonionic surfactant and mixture of these surfactants. See also col.3, lines 8-17. Patent at col.2, lines 56-50 teaches the claimed fatty alcohols and in examples teaches cetyl alcohol claimed. Patent at col.3, under (f) teaches claimed stabilizers and under (g) teaches adding buffer agents so that pH is between 3-5. See examples for additives. Patent '427 at col.1, ll 59-64 teaches adding thickening agent to the compositions. The difference between the patent and the instant application is patent does not teach having amphilic polymer and the hydrophobic unit.

Patent '476 teaches compositions comprising a copolymer wherein one comonomer is acrylamido propyl methyl sulfonic acid (AMPS) or its salts (elected ethylenically unsaturated monomer containing sulfonic group, and one or more macro monomers are chosen from esters of

methacrylic acid with alkyl ethoxylates which include 5-80 ethylene oxide units and 10-22 carbon alkyl radicals. See col. 3, lines 23 - 67; See Example 4. Example 2 teaches using NH₃-neutralized AMPS and Genapol -080, which contains 10-18 carbon fatty alcohol polyglycol ethers with 8 ethylene oxide units. Patent '476 teaches that the degree of neutralization the acids are preferably between 70-100 mol %. See col. 3, lines 8 - 22. Patent '476 also teaches number-average MW of the copolymers, which range from 1000 to 20,000,000 g/mol. See col. 4, lines 9 - 15. Patent '476 also teaches the viscosities of the 1% strength aqueous solutions of the prior art copolymer. Examiner notes that claim 7 is a product-by-process, in which the limitation to the process of making the product will not be considered where the product itself is anticipated by the prior art. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Nonetheless, patent '476 teaches that polymer is prepared by free-radical precipitation polymerization in tert-butanol. See col. 4, line 60- col. 5, line 9. Patent '476 teaches cross-linking the polymers using the claimed cross-linkers, such as methylenebisacrylamide. See col. 4, lines 36 - 29. The reference teaches that the polymers can be random, and that the olefinically unsaturated acids of the polymers can be neutralized by monoalkylammoniums or dialkylammoniums substituted with C₁-C₂₂ alkyl radicals. See col. 3, lines 9 - 22; col. 4, lines 9 - 15. Patent '476 particularly teaches using iso (C₁₆-18) fatty alcohol polyglycol ethers with 25 EO units. See col. 3, lines 60 - 64. The claimed molar proportion of the monomer units in instant claims 30-32 are also disclosed in col. 3, line 65 - col. 4, line 8. Example 48 discloses a shampoo composition. The reference teaches method of making topical compositions by incorporating the amphiphilic polymer to the formulations. **Patent under abstract teaches that these polymers**

are suitable as thickeners. The difference between the patent and the instant application is patent '476 does not teach oxidizing agent claimed in the instant application.

However patent '118 teaches compositions for bleaching hair using oxidizing agent and amphiphilic polymer (thickener). See the abstract. The amphiphilic polymer of patent '118 shares close structural similarity having the same ethylenically unsaturated monomer and it is cross linked with the cross linking agent and this amphiphilic polymer is also a thickener. See the abstract. See col.5, ll 1-30 for the amphiphilic polymer, which is formed from elected species belonging to olefinically unsaturated monomer and crosslink monomer and this cross linking monomer has hydrophobic portion and it is an acrylate. This monomer has an acrylate unit. See also col.3, ll 5-50. See col.5, ll 33-68 for the oxidizing agent, hydrogen peroxide concentration claimed in claims 43-47. See col.7, ll 8-11 for the stabilizer and see col.5, ll 46-49 for pH. Patent '118 at col.2, ll 33-44 teaches that the amphiphilic polymers are thickeners/gelling agents and these gelling agents when mixed with hydrogen peroxide or an oxidizing compound gives transparent gels. See also example 1 for the concentration of hydrogen peroxide and stabilizer.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '627 and substitute the thickener of '427 with the thickener of '476 and patent '118 also suggests the combination of amphiphilic thickener and oxidizing agent using hydrogen peroxide. One of ordinary skill in the art would have reasonable expectation of success that substituting thickener of '427 with the thickener of '476 would yield the same predictable results and patent '118 clearly suggests that the combination of amphiphilic polymer of '476 and hydrogen peroxide would yield transparent and gel and these gels being stable on storage. This is a prima facie case of obviousness.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A. VENKAT/ Ph. D
Primary Examiner
Art Unit 1615